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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/615, 437 07/13/00 KIM

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EXAMINER

LERNER, DAVID, LITTBENBERG,
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HUYNH, P

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

01/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary	Application No. 09/615,437	Applicant(s) KIM, CHRISTOPHER M.
	Examiner " Neon" Phuong Huynh	Art Unit 1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 November 2000.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 29 and 30 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10, 29 and 30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) Interview Summary (PTO-413) Paper No(s) _____.
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other:

DETAILED ACTION

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Dr. Phuong N. Huynh, Art Unit 1644, Group 1640, Technology Center 1600.

2. Applicant's election of Group II, claims 12-18 in Paper No. 4, filed on 11/13/00, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
Claims 1-30 are pending.
Claims 11-28 are being acted upon in this Office Action.
Claims 1-10, 29-30 are withdrawn from further consideration by the examiner, 37 C.F.R. 1.142(b) as being drawn to a non-elected inventions.

3. The declaration cited in the in the PTO Form 1449, filed on 11/16/00, initialized by examiner, have been considered but crossed out since it is not appropriated for publication.

4. The specification is objected as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:
Claim 25 recites wherein said anesthetic is administered in an amount of about 0.1 mg to about 0.3mg per injection. The "0.3mg" recited in claim 25 has no antecedent basis.

5. Claims 12-14, 16-21, 23-25 and 27 are objected to because of the following informalities:
Claims 12, 13 and 14 recite "20:1-1:10", "10:1-1:5" and "3:1-1:1", respectively, are confusing. Applicant should amend the claim to "20:1 to 1:10", for example.
Claims 16-21 and 23-25 lack a space between the number and the unit; applicant should amend the claim to have a space between the number and the unit, "10.0 mg", for example.
Claim 27 recites "25mcm" filter. Applicant should amend the claim to read "25 micron" filter.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The "0.3 mg" recited in claim 25 has no antecedent basis.

Applicant is reminded that the amendment must point to a basis in the specification so as not to add any new matter. See MPEP 714.02 and 2163.06.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 11, 22, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Steigerwaldt *et al.* (AS on PTO 1449, See entire document).

Steigerwaldt *et al.* teaches the use of bee venom and local anesthetic for therapeutic including rheumatoid arthritis (See page 1047, left column second last paragraph bridging page 1048). Specifically, bee venom and local anesthetic was given in therapeutically effective amount to patient by intradermal injection.

Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations would be inherent properties of the referenced methods of bee venom therapy for treating rheumatoid arthritis.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 103(a) that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11, 22, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim *et al.* (AS on PTO 1449; See entire document), in view of Ogram *et al.* (U.S. Patent 6,029,863; See entire document).

Steigerwaldt *et al.* teaches the use of bee venom and local anesthetic, procaine, for therapeutic use including rheumatoid arthritis as discussed supra.

Steigerwaldt *et al.* differs from the claimed invention by not disclosing the use of lidocaine as local anesthetic in the same method.

Ogram *et al.* ('863) teaches a the use of a specific local anesthetic, lidocaine, to reduce pain resulting from bee stings thereby having a calming effect on the victim (See column 2, line 6-13).

Therefore, it would have been obvious to one of ordinary skill in the art to substitute procaine to reduce pain associated with bee venom as taught by Steigerwaldt et al with lidocaine taught by Ogram since both are known to reduce pain associated with bee stings at the time the invention was made. One having ordinary skill in the art at the time the invention was made would have been motivated with a reasonable expectation of success in producing the claimed invention for therapeutic uses as taught by the references.

12. No claim is allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to "Neon" Phuong Huynh whose telephone number is (703) 308-4844. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

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14. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-7401.

Phuong N. Huynh, Ph.D.

Patent Examiner

Technology Center 1600

January 26, 2001



Patrick J. Nolan, Ph.D.

Primary Examiner

Technology Center 1600